REMARKS

Reconsideration of this application is respectfully requested.

Initially, the Applicants would like to thank the Examiner for the indication that claims 7-9 contain allowable subject matter.

In the Official Action, the Examiner rejects claims 1-6 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,458,074 to Matsui et al., (hereinafter "Matsui '074").

In response, Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. § 102(a) for at least the reasons set forth below.

The Examiner argues that Matsui '704 shows all of the limitations of independent claims 1-6. In this regard, the Examiner argues that Matsui '704 shows first and second oscillating bases (citing reference numerals 25 and 26 of Matsui '704). Furthermore, the Examiner argues that Matsui '704 is silent with regard to the end of at least one of the first and second treatment tools guided by the first and second tool oscillating treatment bases is guided to the outside of a field of view from inside of an endoscope image. The Examiner then combines the teachings of Matsui '704 with Matsui '503 (U.S. 6,352,503) to show such a feature, arguing that it "would have been obvious to one skilled in the art at the time the invention was made to enable the treatment tools in the apparatus of Matsui et al. '074 to be guided outside of the field of view of the observation system to clear the field of view of the treatment instruments, thus allowing the operator to view a greater area of body tissue as taught by Matsui et al."

Firstly, Applicants respectfully submit that since the rejection of claims 1-6 is an anticipatory rejection under 35 U.S.C. § 102(a), it is improper to combine two or more

references to reject the claims. Under § 102, all of the features of the claims must be shown in a single reference.[1] Therefore, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102(a) since neither the Matsui '704 nor the Matsui '503 patents show each and every feature of the claims.

Secondly, should the Examiner have meant for the rejection of claims 1-6 to be under 35 U.S.C. § 103(a), Applicants respectfully submit that there is no motivation or suggestion to combine the Matsui '503 and Matsui '704 references. Although the guide tubes (1,2) of Matsui '503 may be capable of moving the instruments outside of the field of view of the endoscope image (by virtue of bending sections 29), there is no motivation or suggestion to combine the Matsui '704 patent with the Matsui '503 patent because the instruments are moved by different mechanisms (by oscillating bases in Matsui '704 and by guide tubes in Matsui '503) therefore, those skilled in the art would not be motivated or suggested to combine them.

Furthermore, Matsui '704 does not contemplate the need to guide the treatment instruments outside of the field of view of the observation system to clear the field of view of the treatment instruments, to allow the operator to view a greater area of body tissue, as argued by the Examiner as the motivation for combination of the Matsui '704 patent and the Matsui '503 patent. Therefore, such a motivation can only have been gleaned in hindsight from the present application, which is improper.

Thus, Applicants respectfully submit that the Examiner, without identifying a suggestion, motivation, or teaching for combining the references, has used impermissible hindsight to combine the Matsui '704 patent and the Matsui '503 patent. The Federal Circuit

[1] Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

in In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998) stated that virtually all inventions are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. **To prevent the use of hindsight based on the invention to defeat patentability of the invention**, the Examiner is required to show a motivation to combine the references that create the case of obviousness. Applicants respectfully submit that the Examiner has not met this burden.

In light of the state of the law as set forth by the Federal Circuit and the Examiner's use of hindsight reasoning with regard to the motivation to combine the cited references, the applicant respectfully submits that even if the rejection of claims 1-6 were made under 35 U.S.C. § 103(a), the same would lack the requisite motivation and would be improper.

Lastly, the Examiner rejects claims 1-4 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 8 of U.S. Patent No. 6,824,509. In response, although Applicants disagree with the Examiner's rejection, in order to advance prosecution, Applicants have submitted herewith a terminal disclaimer disclaiming any portion of the term of a U.S. patent that eventuates from the present application which extends beyond the term of U.S. Patent No. 6,824,509.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 1-4 under the judicially created doctrine of obviousness-type double patenting.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

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